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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/048,009	03/26/98	SARAT	J 032326-003

021839 LM02/0120  
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EXAMINER

ETIENNE, A

ART UNIT	PAPER NUMBER
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2781

DATE MAILED:


01/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No. <b>09/048,009</b>	Applicant(s) <b>SARAT</b>
Examiner <b>Ario Etienne</b>	Group Art Unit <b>2781</b>



☒ Responsive to communication(s) filed on Nov 8, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-31 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 2, 4-13, 15, 16, 18, 19, 21-27, 29, and 31 is/are rejected.

☒ Claim(s) 3, 14, 17, 20, 28, and 30 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2781

***Response to Amendment***

1. The amendment received on 11/8/99 has been entered and carefully considered. Claims 26-31 have been added. Claims 1-31 are now pending in the application.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2781

4. Claims 1, 5-7, 8-10, 11-12, 15, 18, 21-27, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima (5,581,708).

As per claims 1, 5, 8-9, 11-12, 15, 18, 23-24, 26-27, 29 and 31, Iijima discloses a multi-function/protocol smart card comprising a user card containing a microprocessor (CPU) and associated memory and a plurality of contacts for transferring data to and from the microprocessor and memory (see abstract and col. 1-2). The recitation of at least a (first) set of mating contacts in the interface device (card reader) which correspond to a (first) set of contact in the smart/user card that are respectively associated with a set of signals conforming to a (first) protocol is also disclosed by Iijima (see passage above). Although Iijima fails to explicitly disclose a mode contact in the card interface that correspond to another contact of the smart/user card and a mode signal generator for providing a signal which causes the microprocessor in the smart/user card to operate with a second protocol mode when the card is received at the interface device, however, these limitations could be considered implicitly taught or strongly suggested by the reference as one of ordinary skill in the art at the time the invention was made would have found it obvious to provide a mode contact and mode contact generator in order to generate a signal to the mode contact to cause the microprocessor to switch operating mode/protocol because this would increase the flexibility and compatibility of the resulting smart card system.

As per claims 6-7 and 21-22, Iijima fails to provide details regarding the voltage levels of the contacts when the card system operates in each of the protocols. However, official notice is

Art Unit: 2781

taken that both the concept and advantages for maintaining a contact/pin of a card at a predetermined voltage level as to indicate a specific mode of operation of the of the system is well known in the art.

As per claims 10 and 25, the use and advantage for using RC circuits are also well know in the art.

5. Claims 2, 4, 13, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima (5,581,708) in view of Colnot (5,613,159).

Iijima fails to disclose a first protocol to be an ISO protocol and another protocol to be non-ISO protocol. However, such difference is taught or at least suggested by Colnot which discloses a card that can exchange data with other devices following at least two different protocol: the ISO protocol and non-ISO protocol. Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to combine the teachings of Iijima and Colnot to form a system on which these claims read as this would result in the formation of a more flexible and versatile card system.

***Allowable Subject Matter***

6. Claims 3, 14, 17, 20, 28 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2781

*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Larsen et al is cited for disclosing information related to the claimed invention.

Applicants are requested to consider these prior art references for relevant teachings when responding to this office action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ario Etienne whose telephone number is (703) 308-7562. The examiner can normally be reached on Mondays-Thursdays from 7:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached on (703) 305-9648 or at e-mail address [ayza.sheikh@uspto.gov](mailto:ayza.sheikh@uspto.gov).


The fax phone number for this Group is (703) 308-5358.

Art Unit: 2781

9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

*A.E.*

*January 16, 2000*



**ARIO ETIENNE**  
**PATENT EXAMINER**